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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/207,954 12/09/98 YEH

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EXAMINER

TM02/0724

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ART UNIT

PAPER NUMBER

2162

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07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/207,954

Applicant(s)

YEH ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to communication filed on 5/9/2001.
2. Claims 1-44 are presented for examination.

### **Claim Rejections - 35 U.S.C. § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al. (5,974,398, hereinafter Hanson) in view of DeLapa et al.(6,076,068 hereinafter DeLapa).

With respect to claims 14 and 31, Hanson teaches receiving via Internet demographic information corresponding to a subscriber(col. 2, lines 55-, col. 3, lines 1-4 and col. 4, lines 54-60); a storage space, said storage space configured to store a message (database 108); delivering to said subscriber a marketing message(Figure 3). Hanson teaches a customer profile database(102) that contains demographic information about the subscriber such as the age, gender, marital residence, residence, etc. and also Hanson teaches storing marketing messages. Hanson does not specifically teach storing a personal message for a particular customer. On the other hand, DeLapa teaches storing specific messages for specific customers based on their demographics and prior purchasing habits(Abstract). It would therefore have been

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obvious to a person of ordinary skill in the art at the time of Applicant's invention to have modified the marketing messages of Hanson with personalized messages to the subscriber because such a modification would increase the customer's attention to the advertisement.

With respect to claims 15, 16, 32 and 33, Hanson teaches assigning to said subscriber a telephone number and an e-mail address corresponding to said storage space such that said personal message corresponds to a voice message(i.e. the customer can consent to receive a sales call by telephone so that a personalized message based on that customer's demographic can be delivered to the customer)(col. 5, lines 50-, col. 6, lines 1-5); receiving said message via telephone or e-mail (i.e. the message can be supplied by telephone); storing said voice message in said storage space(col. 5, lines 3-21); and retrieving said voice message or e-mail from said storage space(col. 5, lines 3-21). Hanson does not specifically teach that the retrieving of the voice message or e-mail is prior to the delivering step nevertheless it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included retrieving the voice message prior to having the marketing message that corresponds to the customer demographic information delivered because such a modification would notified the customer that a personalized message would be forthcoming.

Claims 17 and 34 further recite assigning a password corresponding to said storage space and delivering said messages to the subscriber if the password corresponds. Hanson further teaches a database wherein service issues such as

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security, passwords, and the like is stored(col. 4, lines 54-60) therefore it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included having the customer use the passwords before the delivery of the messages because such a modification would provide security(col. 4, lines 54-60).

5. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over publication, titled, Mendler "Competition drives operators toward retail innovation" hereinafter Mendler.

With respect to claim 35, Mendler teaches receiving a telephone call from a caller(i.e. the customer calls an MCI operator and provide the numbers of their closest friends)(page 3, paragraph 5); querying said caller for a third-party telephone number(page 3, paragraph 5); receiving said third-party telephone number(i.e. the operator receives the third-party telephone numbers to enable the customer to receive discounts calls on those specified numbers)(page 3, paragraphs 4-5).

With respect to initiating a telephone call between said caller and the third party and delivering to said caller and said third party a marketing message during said telephone conference call. Since, the MCI system is partly responsible for taking 5 percent of AT&T's market share(page 3, paragraph 4) and since it is well known to place conference calls that deliver marketing messages. For example, mortgage companies would call the individuals responsible for decision making by conference calls to deliver marketing message that would motivate both parties to agree on certain specifics of a proposed deal or contract. It would have been obvious to a person of ordinary skill in the

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art at the time of Applicant's invention to have included delivering a conference marketing message to the friends and family of the customer because such a modification would save time by enabling the MCI operators to deliver the same message to the two parties at the same time.

Claim 36 differs from claim 35 in that it further recites receiving a call from a caller having a calling card, said calling card having a predetermined number of minute credits associated with it. Official notice is taken that is old and well known for callers to place phone calls with calling cards said calling cards have a predetermined number of minutes based on the money amount purchased. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a calling card because such a modification would enable the caller to prepay for the call ahead of time.

Claim 37 further recites adding an additional number of minutes credits to said calling card when said marketing message is delivered. Official notice is taken that is old and well known to credit or pay customers for their attention to advertisements. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included adding a credit to said calling cards when said marketing message is delivered because such a modification would motivate the customers to listen to the message.

6. Claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, 41 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann et al. (5,933,778 hereinafter Buhrmann) in view of Civanlar (EP 0 732 835 A 2 hereinafter Civanlar).

With respect to claims 1, 4, 5, 11, 12, 18, 21, 22, 28-30, Buhrmann teaches receiving a time, a date and telephone number for a reminder telephone call(col. 11, lines 34-66); storing in a database said time, date and telephone number of said reminder telephone call(i.e. the alert processor scans the subscriber profile stored in the database to obtain the alert message information, such at the time that the alert message is to be delivered, the date and the telephone number that the alert message is to be delivered to)(col. 11, lines 34-66); and delivering said reminder telephone call at said specified time, date and telephone number(i.e. the alert message(reminder message) is sent to its destination)(col. 11, lines 34-, col. 7, lines 1-17).

Buhrmann does not specifically teach that the message receive is associated with a product or service provider but since, Buhrmann teaches that the system maintains a subscriber profile database(118) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using the subscriber profile database to generate a message associated with a product or service provider of interest to the subscriber.

Buhrmann teaches delivering the message over telephone. Buhrmann does not specifically teach that the step of receiving the information is via the Internet. On the other hand, Civanlar teaches providing a client-server architecture utilizing the Internet and public switched networks wherein it receives the client information over the Internet connection and handles the client's request by using the telephone number provided by the client(col. 6, lines 34-, col. 7, lines 1-7). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving the

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information via the Internet and delivering the service over the telephone because such a modification would guarantee quality of service, security, and easy and flexible mechanism to charge for the information and transmission services which are all expected from a complete information network(col. 1, lines 20-25).

With respect to claims 38 and 41, the claims differ from claim 1 in that it further recites delivery of an e-mail reminder telephone call. Official notice is taken that is old and well known to send mail(e-mail) message to remind patients to call the doctor's offices to schedule yearly routine check ups. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included receiving via the Buhrmann management system an e-mail reminder telephone call because such a modification would allow the subscriber to open the e-mail at a time that is convenient for him or her.

With respect to claims 42 and 43, the claims further recite receiving from a subscriber a name and a topic. Official notice is taken that is old and well known for e-mail to contain the name of the sender along with the topic of the message. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a name and a topic for the specific e-mail message because such a modification would allow the receiver to know who the sender is and what the message is about before the message is open.

With respect to claims 9, 26 and 44, the claim further recites receiving from the subscriber a specifiable number corresponding to a number of e-mail messages. Since, in Buhrmann the subscriber can specify the number of alert messages that he or



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she wants to receive at a specified time period specified by the customer(col. 11, lines 34-, col. 12, lines 1-17). If the receiving step was to be performed by e-mail then it would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to have included an specifiable number corresponding to the number of message that the customer is to received to obtain the benefits above mentioned.

7. Claims 2, 3, 6-8, 10, 19, 20, 23, 24, 25, 27, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buhrmann et al. (5,933,778 hereinafter Buhrmann) in view of Civanlar (EP 0 732 835 A 2 hereinafter Civanlar) further in view of Hanson et al.(5,974,398 hereinafter Hanson).

With respect to claims 2, 19 and 39, Buhrmann further teach that the telephone call further comprises a message(col. 11, lines 29-, col. 12, lines 1-17). The combination of Buhrmann and Civanlar does not specifically teach that the message is a marketing message. On the other hand, Hanson teaches sending marketing message to the subscriber based on the customer's interest profiles and service usage(Abstract). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included including modifying the message of Buhrmann with marketing message because such a modification would provide a more productive message that the customer most likely be interested in.

With respect to claims 3, 20 and 40, the combination of Buhrmann and Civanlar further teach receiving via the Internet information corresponding to a subscriber and delivering the message during a reminder telephone call. The combination of

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Buhrmann do not specifically teach that the information is demographic information and matching the marketing message to the demographic information. On the other hand, Hanson teaches obtaining demographic information to enable marketing message to be delivered based on the particular client's demographic(Figures 1-15). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included obtaining demographic information and using the demographic information to market the messages because such a modification would provide a more productive message that the customer most likely be interested in.

With respect to claims 6 and 23, Hanson further teaches that the information is selected from a group consisting of news and information (col. 3, lines 13-24). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the information selected from a group consisting of news and information because such a modification would provide a variety of information available to the client based on their interests and likes.

With respect to claims 7 and 24, Hanson further teaches receiving a signal from the subscriber during the delivery of the corresponding marketing message and delivering to said subscriber additional information corresponding to said marketing message(i.e. in response to the user having selected one of several advertisers, a corresponding message with additional information on the selected message is retrieved and delivered to the customer)(col. 10, lines 53-, col. 11, lines 1-5). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included additional information corresponding to the marketing

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message in response to receiving a signal from the customer because such a modification would help better target the advertisement based on the particular customer tastes and likes.

Claims 8 and 25 further recites that the signal is generated by pressing a button on the telephone. Since, in Buhrmann the delivery of the messages is via a telephone then it would have been obvious to press a button on the telephone to receive the user's selections.

With respect to claims 10 and 27, Hanson further teaches that the additional information comprises a hyperlink text(col. Col. 10, lines 53-65). It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to have included supplying the additional information via a hyperlink text because such a modification would provide easier access to the additional information.

### **Response to Arguments**

8. Applicant's arguments filed 5/9/2001 have been fully considered but they are not persuasive.

A. Hansen teaches assigning and storing a storage space based on the customer's demographic information as shown in figure 3, what Hansen does not teach is that when the customer accesses said personal message a marketing message is delivered to the subscriber. De lapa, on the other hand fills this gap by allowing a subscriber(customer) to accesses his personal message(targeted coupons) and when he or she does a marketing message is displayed (i.e. the customer might have

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accumulated sufficient purchases to win a prize, which are based on attribute of the household)(col. 13, lines 42-64).

B. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, De Lapa teaches that when the customer accesses his personal message(i.e the targeted coupons are personal message because they are personal or specific to the customer's attributes) a marketing message is displayed(i.e. the customer gets a displayed on his accumulated purchases and prizes). The motivation to combine this references is in Delapa at columns 2, lines 66-, col. 3, lines 1-5 which states that " **Retail establishments, such as grocery stores, often develop promotional campaigns designed to encourage increased purchases among its frequent shopper members. An example of such a campaign is a program which gives away a valuable item, such as turkey or ham, to a frequent shopper member who purchases a given amount of merchandise within a predefined period of time"**

C. With respect to place conference calls that deliver marketing message, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teach placing conference calls that deliver marketing message , per SE, but

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rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of this feature. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, in re Bozek, 163 USPQ 545(CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in re Delisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and in re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598(Fed. Cir. 1988)(citing in re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed.Cir. 1988)). Further, it was determined In re Lamberti et al, 192 USPQ 275(CCPA) that:

- (I) obviousness does not require absolute predictability;
- (II) non-preferred embodiments of prior art must also be considered; and
- (III) the question is not express teaching of references, but what they would suggest.

According to In re Jacody, 135 USPQ 317 (CCPA 1962) the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In re Bode, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

D. With respect to the arguments of claim 38, all the limitations of claim 38 were addressed in the rejection to claim 1. The feature not addressed in claim 1 was the additional feature in claim 38 of receiving a telephone call reminding the subscriber of

an e-mail message. The Examiner has taken official notice that it is old and well known for patients to receive telephone calls from doctor's offices reminding them of a letter or mail (e-mail) that they might receive. for example, a bill that is overdue and because the patient couldn't be contacted, it was sent to a collection agency and therefore the patient receives a call telling them that a letter from a collection agency would be forthcoming.

### **Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

### **Points Of Contact**

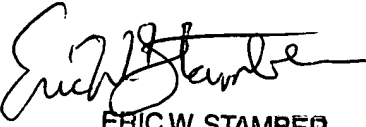
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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-0040 for regular communications and (703)305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

R.A.  
July 20, 2001

  
ERIC W. STAMBER  
PRIMARY EXAMINER